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David Brian Wecker

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EXAMINER

STORK, KYLE R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/091,276	Applicant(s) WECKER ET AL.	
	Examiner KYLE R. STORK	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is in response to the amendment filed 26 March 2008.
 2. Claims 1-20 are pending. Claims 21-25 are cancelled by the amendment.
- Claims 1 and 16 are independent claims.

The rejection of claims 1-2, 4-5, 16-17, and 20-21 under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US 7068724, filed 20 October 2000) has been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8, 10, 15-18, and 20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ozer et al. (US 2004/0110171, filed 21 November 2001, hereafter Ozer)

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per independent claim 1, Ozer discloses a method for providing archived material comprising:

determining that an accompanying non-requested item of a plurality of items is substitutable (paragraph 0022: Here, the current stored ad (non-requested item) is deleted and a new ad replaces the stored ad. This requires determining that the current stored ad is substitutable)

selecting a new item according to at least one rule, the at least one rule comprising selecting the new item based on a geographical location associated with a requestor of the archived material (paragraph 0020 and 0054-0055: Here, rules engine determines the ad to substitute based upon a plurality of factors, one of these factors being the geographical location of the targeted user)

generating a second instance of archived material by replacing the at least one substitutable item in the first instance with the new item, wherein the replaced substitutable item comprises a portion less than all of the second instance (paragraph 0022)

delivering the generated second instance to a requestor of the archived material (paragraphs 0020 and 0054-0055)

Ozer does not specifically disclose retrieving a first instance of archived material comprising a plurality of items, the plurality of items comprising at least one requested item and at least one accompanying, non-requested, item. However, Ozer discloses

retrieving a web page having a banner ad (paragraph 0046: Here, a web page is a formatted text document, while the banner ad is a text or non-text item). The retrieval of the web page requested by a user comprises the requested item. While it is not specifically disclosed that the user does not request the banner ad, if only a request for the web page is submitted, the banner ad is inherently a non-requested item.

As per dependent claim 2, Ozer disclose the method further comprising charging a fee to a provider of the new item for replacing the at least one substitutable item with the new item (paragraph 0011).

As per dependent claim 3, Ozer discloses the method further comprising rendering the second instance of archive material (paragraph 0023).

As per dependent claim 4, Ozer discloses wherein the first instance is retrieved from a data store resident on a first computing device, and wherein the method further comprises transmitting the second instance to a second computing device communicatively coupled to the first device (paragraph 0043: Here, a networked first device transmits data to a second device).

As per dependent claim 5, Ozer discloses wherein the substitutable item comprises a current advertisement (paragraphs 0020 and 0054-0055).

As per dependent claim 6, Ozer discloses wherein the substitutable item has a first position on a page and a first size, the new item has a second position on the page and a second size and the first size is substantially identical to the second size and the first position is substantially identical to the second position (paragraphs 0082-0084).

As per dependent claim 7, Ozer discloses wherein at least a particular one of the plurality of items is described by meta-data (paragraph 0057).

As per dependent claim 8, Ozer discloses wherein the meta-data comprises geometric data which specifies the position of the item on a page (paragraph 0082-0084).

As per dependent claim 10, Ozer discloses wherein the meta-data comprises a temporal relevancy data which represents a date beyond which the item is substitutable (paragraph 0057: Here, the temporal content specifies when the content is suitable for display, and thus when it is substitutable).

As per dependent claim 15, Ozer discloses wherein determining that at least one of the plurality of items is substitutable is based on the at least one item being outdated (paragraph 0046: Here, if the requested advertising impressions has been met, the ad is outdated, and is substitutable with more current advertising content).

As per independent claim 16, the applicant discloses the limitations substantially similar to those in claim 1. Ozer fails to specifically disclose wherein the requested item comprises text and at least one image. However, it was notoriously well known at the time of the applicant's invention that a web page including a banner ad may contain text and image data.

As per dependent claim 17, the applicant discloses the limitations substantially similar to those in claim 5. Claim 17 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations substantially similar to those in claim 15. Claim 18 is similarly rejected.

As per dependent claim 20, the applicant discloses the limitations substantially similar to those in claim 4. Claim 20 is similarly rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 10, 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US 7068724, filed 20 October 2000) and further in view of Dutta (US 2002/0109729, filed 14 December 2000).

As per independent claim 1, Hamilton discloses a method for providing material comprising:

Retrieving a first instance of material comprising a plurality of items, the plurality of items comprising at least one requested item and at least one accompanying, non-requested item (column 7, line 62- column 8, line 13: Here, the requested program is the first item, while an advertisement is an accompanying non-requested item)

Determining that the at least one accompanying, non-requested item of the plurality of items is substitutable (column 7, line 62- column 8, line 13)

Selecting a new item according to at least one rule, the at least one rule comprising selecting the new item based on a geographic location associated with a requestor of the material (column 7, line 62- column 8, line 13: Here, the original

advertisement is substituted with a local advertisement based upon the geographic location of the requestor of the program)

Generating a second instance of the material by replacing the at least one substitutable item in the first instance with the new item, wherein the replaced substitutable item comprises a portion less than all of the second instance (column 7, line 62- column 8, line 13)

Delivering the generated second instance to a requestor of the material (column 7, line 62- column 8, line 13)

Hamilton fails to specifically disclose wherein the material is archived material. However, it was notoriously well known in the art at the time of the applicant's invention that material may be archived. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention that applying Hamilton to archived content would have allowed advertisement sellers to generate more revenue based upon target advertisement (Hamilton: column 7, line 62- column 8, line 13).

Hampton fails to specifically disclose wherein the requested data is formatted text data. However, Dutta discloses use of a web page, which is formatted text data (paragraph 0054). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta with Hamilton, since it would have allowed for the content data to be displayed without modifying the data for display.

As per dependent claims 2, Hamilton further discloses charging a fee to a provider of the new item for replacing the at least one substitutable item with the new item (column 7, line 62- column 8, line 13).

As per dependent claim 3, Hamilton further discloses rendering the second instance of the material (column 7, line 62- column 8, line 13: Here, the content containing the substituted advertisement based upon geographic location is displayed to a user).

As per dependent claim 4, Hamilton fails to specifically disclose wherein the first instance is retrieved from a data store resident on a first computing device, and wherein the method further comprises transmitting the second instance to a second computing device communicatively coupled to the first computing device. However, it was notoriously well known in the art at the time of the applicant's invention that access to cable content is a client-server relationship. The cable provider acts as a server, providing requested data to a client via a cable box. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined a client-server relationship with Hamilton, thereby allowing for users to request content for display.

As per dependent claim 5, Hamilton discloses wherein the substitutable item comprises a substitutable advertisement and the new item comprises a current advertisement (column 7, line 62- column 8, line 13).

As per dependent claim 6, Hamilton discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Hamilton fails to specifically disclose wherein the substitutable item has a first position of a page and a first size, the new item has a second position on the page and a second size and the first size is substantially identical to the second size and the first position is substantially identical to

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the second position. However, Dutta discloses wherein the substitutable item has a first position of a page and a first size, the new item has a second position on the page and a second size and the first size is substantially identical to the second size and the first position is substantially identical to the second position (paragraph 0054). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta with Hamilton, since it would have allowed for the content data to be displayed without modifying the data for display.

As per dependent claim 7, Hamilton discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Hamilton fails to specifically disclose meta-data. However, Dutta discloses use of meta-data (paragraph 0054: Here, information about the advertisement and data, such as the size of the advertisement space, are known). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta with Hamilton, since it would have allowed for similar size content to be inserted into a similar size space.

As per dependent claim 8, Hamilton and Dutta disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Dutta discloses wherein the meta-data comprises geometric data which specifies the position of the item on a page (paragraph 0054). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta with Hamilton, since it would have allowed a user place substitute advertisement data into the same position as the original data.

As per dependent claim 10, Hamilton and Dutta disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Dutta discloses wherein the meta-data comprises temporal relevance data which represents a data beyond which the item is substitutable (paragraph 0054). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta and Hamilton, since it would have allowed for expired advertisements to be replaced with current advertisements.

As per dependent claim 15, Hamilton discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Hamilton fails to specifically disclose determining suitability based upon the date of the item. However, Dutta discloses determining suitability based upon the date of the item (paragraph 0054). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Dutta and Hamilton, since it would have allowed for expired advertisements to be replaced with current advertisements.

As per independent claim 16, the applicant discloses the limitations substantially similar to those in claim 1. Claim 16 is similarly rejected.

As per dependent claim 17, the applicant discloses the limitations substantially similar to those in claim 5. Claim 17 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 15. Claim 18 is similarly rejected.

As per dependent claim 20, the applicant discloses the limitations substantially similar to those in claim 4. Claim 20 is similarly rejected.

7. Claims 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton and Dutta, and further in view of Austin (US 6701315, filed 20 June 2000).

In regard to dependent claim 9, Austin discloses wherein the meta-data comprises category data that specifies that the particular one of the items is either text, collateral content, or an image (Austin Col 6 Lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin with Hamilton, thereby providing a user the benefit of displaying geographically targeted banner ads in a multimedia web page.

In regard to dependent claim 11, Austin discloses wherein the meta-data comprises a link to information related to the item (Austin Col 6 Lines 3-10). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin with Hamilton, thereby providing a user the benefit of displaying geographically targeted banner ads in a multimedia web page.

In regard to dependent claim 12, Austin discloses wherein the related information comprises at least one of: a document, a text item, an image item, a collateral content item, and a coupon (Austin Col 9 Lines 54-60) (Austin Col 6 Lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin with Hamilton, thereby providing a user the benefit of displaying geographically targeted banner ads in a multimedia web page.

In regard to dependent claim 13, Austin discloses wherein the meta-data comprises business information (Austin Col 6 Lines 3-10). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Austin with Hamilton, thereby providing a user the benefit of tracking advertiser data for billing purposes.

8. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton and Dutta, and further in view of Stefik (US 5715403, filed 23 November 1994).

In regard to dependent claim 14, Hamilton does not specifically disclose wherein the business information comprises at least one of item provider, item owner, item sponsor, and cost. However Stefik discloses a cost (Stefik Col 24 Lines 42-55). It would have been obvious to one of ordinary skill in the art to apply Stefik to Hamilton providing the benefit of having a cost so the user can know a price before accessing information.

In regard to dependent claim 19, Hamilton does not specifically disclose wherein the second advertisement is determined to be current by comparing a date on which a request is received with an expiration date associated with the second advertisement, wherein said system date predates said expiration date. However Stefik discloses of an expiration date (Stefik Col 22 Lines 1-9). It would have been obvious to one of ordinary skill in the art to apply Stefik to Hamilton providing the benefit of having an expiration date so the user can know which advertisements are current.

Response to Arguments

9. Applicant's arguments filed 26 March 2008, with respect to Ozer have been fully considered but they are not persuasive.

The applicant argues that Ozer discloses data as video type programming, and thus does not disclose a formatted text document (pages 6-7). However, the examiner respectfully disagrees. Ozer discloses displaying banner ads within a web page presented to a user (paragraph 0082). This web page contains advertisements for goods and services (paragraph 0068). Therefore, this argument is not persuasive.

10. Applicant's arguments with respect to Hamilton have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyle R Stork
Examiner
Art Unit 2178

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